



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No: 09/627,796  
Date Filed: July 28, 2000  
Application Title: Non-Nucleic Acid Probes, Probe Sets, Methods And Kits  
Pertaining To The Detection Of Individual Human  
Chromosomes X, Y, 1, 2, 3, 4, 6, 7, 8, 9, 10, 11, 12, 16, 17, 18  
And 20 As Well As 13/21 As A Pair  
Applicants: Krishan L. Taneja  
Group Art Unit: 1655  
Examiner: Jehanne E. Souaya  
Action Date: September 21, 2001  
Action Type: Restriction/Election Requirement  
Certified Mail No.: 7099 3400 0007 5728 5668

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37 C.F.R. §1.8

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Brian D. Gildea  
Reg. No. 39,995

Commissioner for Patents  
Washington, DC 20231

Dear Sir or Madam:

A petition for an automatic three-month extension of time has been included with the papers accompanying this document so please consider the following response to the Office Action mailed on September 21, 2001.

I. ACTION SUMMARY

Claims 1-45 stand pending in this application. The Examiner has argued that claims 1-15, 21-23 and 29-54 are subject to a restriction/election requirement.

II. RESPONSE TO THE RESTRICTION REQUIREMENT

In the present Office Action, the Examiner takes the position that, with respect to claims 1-15, 21-23 and 29-45, a restriction requirement is proper in view of 35 U.S.C. § 121.

Applicants hereby respectfully traverse the present restriction requirement as being clearly contrary to the express holding of *In re Weber*. *In re Weber* holds that:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be "independent and distinct". It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis. *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

**We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses** (emphasis added). *In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

Accordingly, it is clear from *In re Weber* that the legal issue of whether or not The Office may impose a restriction requirement to a **single claim** has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 112, where the applicant is statutorily entitled to claim his invention as he deems proper, notwithstanding 35 U.S.C. § 121. This is true whether or not the inventions are determined by The Office to be independent and distinct.

Applicants further note that with each Group that the Examiner argues is a separate invention (i.e. Groups I-XVIII), they are each similarly classified in Class 536, subclass 23.1 and Class 435, subclass 6. Thus, for purposes of a search, there is no additional burden placed upon The Office since the same class and subclasses must be

searched, and no additional Class or subclass must be searched, whether or not the restriction requirement is imposed.

Additionally, Applicants take the position that said claims are generic and use proper Markush format. Accordingly, Applicant takes the position that the present restriction requirement is improper and therefore request that it be withdrawn.

Because the rules REQUIRE that Applicant's make an election, notwithstanding any traverse of a restriction requirement, the provisional election of Group II probes drawn to Human Chromosome X (Seq. ID Nos. 10-16) is chosen. However, because Applicants traverse the restriction requirement, no amendment or cancellation of claims has been offered in this response as Applicants reserve their right to appeal said restriction requirement.

### III. SUMMARY

It is believed that this response addresses all rejections set forth in the present Office Action and the application is in ready condition for allowance. In consideration of the preceding remarks, Applicants hereby respectfully request reconsideration of all pending claims, the withdrawal of all rejections set forth in the present Office Action and issue of a Notice of Allowance by The Office.

### IV. INTERVIEW

If the Examiner believes a telephonic or personal interview would advance the prosecution of the subject application, the Examiner is invited to contact attorney Gildea during business hours at the telephone or facsimile numbers listed below.

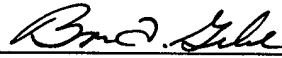
### V. ENCLOSURES

Enclosed herewith please find:

- 1) A petition, under 37 C.F.R. § 1.136 (a), for an automatic three month extension of time to respond to the present Office Action and authorization to charge the appropriate fee therefore.

VI. FEES

A petition for an automatic three month extension of time under 37 C.F.R. § 1.136 (a), and fee paid pursuant to 37 C.F.R. § 1.17, has been included with the papers accompanying this response. No additional fees are believed due The Office for consideration of this paper. If however, The Office determines that any other fee is due, authorization is hereby granted to charge any required fee associated with the filing of this paper to Deposit Account 02-3240.



Brian D. Gildea, Reg. No. 39,995

IX. CORRESPONDENCE/CUSTOMER NUMBER

Please send all correspondence pertaining to this document to:

Boston Probes, Inc.  
Attn: Brian D. Gildea, Esq.  
15 DeAngelo Drive  
Bedford, MA 01730

Telephone: 781-271-1100 ext. 224  
Fax: 781-276-4931

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Respectfully submitted  
on behalf of Applicants,



Brian D. Gildea, Esq.  
Reg. No. 39,995